

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. 10/690,125

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Title: METHOD FOR ACCESSING EMAIL
ATTACHMENTS FROM A MOBILE VEHICLE

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SECOND APPEAL BRIEF

Board of Patent Appeals and Interference
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is being filed in support of Appellants' appeal of the rejections made in the Final Office Action dated May 12, 2008.

Appellants note that this most recent Office Action was improperly made final on the asserted basis that it was necessitated by Appellants' amendments. However, factually this is incorrect. The Office Action was, in fact, a re-opening of prosecution by the Examiner following Appellants' filing of the first Appeal Brief. Those arguments having apparently been persuasive, the Examiner then re-opened prosecution to enter new grounds of rejection. Since the new ground of rejection was not necessitated by any amendment nor the result of new prior art presented in an Information Disclosure Statement, the rejection should not have been made final. See MPEP § 1207.04.

(i) Real Party in Interest

The real party in interest is the assignee of the applicant inventors who assigned all of their right, title and interest to General Motors Corporation, a Michigan corporation, having its principal place of business at 300 Renaissance Center, Detroit, Michigan 48265-3000.

(ii) Related Appeals and Interferences

There are no other appeals and/or interferences known to the Appellants, their assignee, and/or legal representatives that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(iii) Status of Claims

In the Final Office Action, claims 1-21 were rejected under 35 U.S.C. §103(a). The application does not contain any other claims. The rejections of claims 1-21 are being appealed.

(iv) Status of Amendments

No amendments have been made subsequent to the Final Office Action of May 12, 2008.

(v) Summary of Claimed Subject Matter

In accordance with 37 CFR 41.37(c)(1)(v), a concise explanation is provided below of subject matter defined in each of the independent claims involved in this appeal, with reference to the specification by page and line numbers and to the drawings by reference characters. Also in accordance with 37 CFR 41.37(c)(1)(v), for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function as permitted by 35 U.S.C. 112, sixth paragraph, is identified and the structure, material, or acts described in the specification as corresponding to each claimed function is set forth with reference to the specification by page and line numbers, and to the drawings by reference characters.

Independent Claim 1 –

Independent claim 1 is directed to a method for accessing an email attachment from a mobile vehicle 110 (Fig. 2; Page 11, Lines 1-2). The method includes receiving an email attachment from a remote server (e.g., 164) at a vehicle telematics unit 120 (Fig. 2, Step 214; Page 12, Lines 23-25), determining at the vehicle a classification of the email attachment (Fig. 2, Step 216; Page 13, Lines 13-16), and routing the email attachment within the vehicle 110 based on the classification such that the email attachment is provided to a vehicle communication unit (e.g., 112, 114) enabled to present the content of the email attachment (Fig. 2, Step 218; Page 13, Lines 19-26).

Independent Claim 8 –

Independent claim 8 is directed to a computer readable medium 128 (Fig. 1; Page 4, lines 18-21) storing a computer program to receive email attachments at a vehicle 110 (Fig. 2; Page 2, Lines 9-10). The computer program comprises computer readable code for receiving an email attachment from a remote server (e.g., 164) at a vehicle telematics unit 120 (Fig. 2, Step 214; Page 12, Lines 23-25), computer readable code for determining at the vehicle 110 a classification of the email attachment (Fig. 2, Step 216; Page 13, Lines 13-16), computer readable code for routing the email attachment within the vehicle 110 based on the classification such that the email attachment is provided to a vehicle communication unit (e.g., 112, 114) enabled to present the content of the email attachment (Fig. 2, Step 218; Page 13, Lines 19-26).

Independent Claim 15 –

Independent claim 15 is directed to a system 100 for accessing an email attachment from a vehicle 110 (Fig. 2; Page 2, Lines 17-18). That system 100 includes a means 122/124/128 for receiving an email attachment from a remote server (e.g., 164) at a vehicle telematics unit 120 (Fig. 1; Page 4, lines 18-21; Fig. 2, Step 214; Page 12, Lines 23-25), means 122/128 for determining at the vehicle 110 a classification of the email attachment (Fig. 1; Page 4, lines 5-17; Fig. 2, Step 216; Page 13, Lines 13-16), and a means 120 for routing the email attachment within the vehicle based on the classification such that the email attachment is provided to a vehicle communication unit (e.g., 112, 114) enabled to present the content of the email attachment (Fig. 1; Page 5, lines 15-25; Fig. 2, Step 218; Page 13, Lines 19-26).

Although the Appellants have provided the summary of claimed subject matter with references to specific embodiments of the invention to comply with the requirements set forth in the relevant provisions of 37 C.F.R., this summary has been provided to aid the Board in evaluating the appeal and is not intended to limit the meaning or definition of any terms in the claims. Furthermore, it should be appreciated that the above-provided reference numerals and pages/line numbers are only for exemplary purposes, as other instances and/or embodiments of the claimed elements could appear elsewhere in the application.

(vi) Grounds of Rejection to be Reviewed on Appeal

The issues on appeal are as follows:

1) whether claims 1-3, 8-10, and 15-17 are unpatentable under 35 U.S.C. §103(a) as being obvious over Sharif et al. (U.S. Patent No. 7,194,513) in view of Bastian et al. (U.S. Patent No. 6,757,712);

2) whether claims 4, 11, and 18 are unpatentable under 35 U.S.C. §103(a) as being obvious over Sharif in view of Bastian and in further view of Lazaridis (U.S. Patent No. 6,219,694);

3) whether claims 6, 7, 13, 14, 20, and 21 are unpatentable under 35 U.S.C. §103(a) as being obvious over Sharif in view of Bastian and further in view of Ban et al. (U.S. Patent Publication No. 2005/0060373); and

4) whether claims 5, 12, and 19 are unpatentable under 35 U.S.C. §103(a) as being obvious over Sharif in view of Bastian and Lazaridis, and further in view of official notice taken by the Examiner

(vii) Argument**Claims 1-3, 8-10, and 15-17**

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Sharif in view of Bastian. The Appellants respectfully traverse this rejection because not only does it fail to establish a *prima facie* case of obviousness, but also the claimed subject matter is not, in fact, disclosed or otherwise rendered obvious by these references.

Sharif is directed to a system designed to enable access to the World-Wide Web without the use of a personal computer such as by using an ordinary television set and a remote control. For this purpose, Sharif teaches a plurality of Internet appliances 1910-1914 (called EdenboxTM), that send and receive electronic mail using a remote UNIQA server 1908 that stores all digital files and interfaces with an Internet POP server 1906 for email reception and delivery.¹ Thus, all email attachments are processed and stored at the remote server. When mail is received, the server processes the mail to split the body and the attachments, prepares the files so that the Internet appliance can view them, and stores them in the client's directory at the remote server.² Sharif discloses downloading available email for a client into separate files at the UNIQA server 1908 when email is available.³ The mail process determines if there is an attachment, the files are MIME decoded, and stored in individual image and audio files. All of these files are copied to a predefined mail directory of the client's data directory in the server. There is only one predefined mail directory for a user and all mail files are stored there.⁴

Bastian is directed to permitting passengers on board an aircraft to send and receive electronic data to and from an electronic base station. To avoid the time and expense of transmitting large amounts of electronic data, Bastian teaches a system where data sent from the base station to the server is first analyzed to determine its structure, such as whether an email attachment exists. The base station then sends the email message along with only a brief description of the email attachment to the aircraft server for delivery to the passenger. Transmitting the brief description rather than the entire structure or attachment reduces the

¹ Sharif et al., Fig. 19 and col. 3, line 58, to col. 4, line 7.

² Sharif et al., col. 2, lines 64-67.

³ Sharif et al., col. 10, lines 36-38.

⁴ Sharif et al., col. 10, lines 52-60.

bandwidth required to transmit email from the ground to the aircraft. To implement his system, Bastian discloses a method called Intelligent Mail Management (IMM) for transferring mail between the base station and server. The IMM protocol analyzes email messages to identify the components of the messages. For instance, if an email includes a text message and two attachments, these attachments are identified to the server. But the attachments themselves are not sent from the base station to the server as it is impracticable to send large attachments via the slow communications links. Rather, the IMM method sends a summary of the email received at the base station from the passenger's mail server to the server on board the aircraft. If, after receiving the email and attachment summary, the passenger wishes to receive the attachment, they can do so for a fee.

Appellants' claim 1 is directed to a method for accessing an email attachment from a mobile vehicle. The method includes receiving an email attachment from a remote server at a vehicle telematics unit, determining at the vehicle a classification of the email attachment, and routing the email attachment within the vehicle based on the classification such that the email attachment is provided to a vehicle communication unit enabled to present the content of the email attachment. While the recited limitations of claims 1, 8, and 15 are different, the arguments below apply equally to all of the independent claims.

The Examiner has not provided a *prima facie* case of obviousness under 35 U.S.C. § 103(a) because the Examiner has not reasonably identified disclosure from Sharif and Bastian that teaches or otherwise renders obvious the subject matter of Appellants' claims, nor has the Examiner properly established how either reference would be modified to render Appellants' claims obvious. To the contrary, as discussed below, the subject matter of Appellants' claims is not obvious in view of the applied references.

1) Claims 1, 8, and 15 – Sharif Does Not Disclose Appellants' Steps, Either in a Vehicle or Elsewhere

The Examiner argues that Sharif teaches the invention substantially as claimed, but in doing so fails to provide a reasonable rationale or support for this rejection. For instance, the Examiner cites Sharif as disclosing the claimed classifying and routing of email attachments. But this statement relies on unreasonable interpretations of the claim language and ignores some

of the express teachings of Sharif. That is, it ignores Sharif's clear teaching that its system involves receiving and storing email attachments at a remote server and then only delivering them to the user after being formatted into a special (TV-HTML) file format that is sent to the user's Internet appliance. Thus, all processing is carried out at the remote server, not the Internet appliance. In particular, Sharif's system permits the "receiving and viewing-of/listening-to video/audio digital content files that arrive as email attachments."⁵ But as Sharif makes clear in the abstract and elsewhere, "all digital content files are maintained at the server and accessible at the Internet appliance only for viewing via browser and listening." Or in other words, a client's email is received from the Internet at the remote server (the UNIQA server 1908) where email attachments (if any) are separated from the email and stored. The client may access the content of the attachment, but the actual file itself remains at the server and is only thereafter supplied to the Internet appliance (and thus, the user) after being formatted into a TV-HTML document. Sharif is unambiguous in making this point and does so repeatedly. See col. 4 of Sharif which state that "all digital content files within the UNIQA system 1904 reside in storage at the UNIQA server 1908, and are available in TV-HTML format to a browser within each Internet appliance."⁶ Sharif continues stating that "the digital content files are not stored at the Internet appliances." See also, col. 4, lines 42-45. As such, all of the processing of the attachments are carried out at the server with the Internet appliance doing nothing with the attachments except presenting TV-HTML versions of them via an attached television. Thus, in Sharif, there is no determination of email attachment classification or routing at a vehicle or other client location.

The Examiner very vaguely argues that Sharif both identifies attachment types and routes email based on the identified types.⁷ He cites several sections of Sharif, but none disclose either classifying attachment types or routing the attachments based on type.⁸ Rather, in Fig. 4, step 422, Sharif teaches using a test to determine whether an attachment type is supported by the UNIQA server. The attachment is then either saved or discarded based on the determination. But determining whether an attachment type is supported and then saving or discarding it cannot reasonably be equated with classifying an attachment and then routing it based on the

⁵ Sharif et al., abstract.

⁶ Sharif et al., col. 4, lines 8-12.

⁷ Final Office Action, May 12, 2008, page 3, lines 1-6.

⁸ See Sharif et al., Fig. 4; col. 9, line 40-col. 10, line 31.

classification. And, more importantly, even if these steps were to be considered classifying and routing of an attachment, Sharif clearly teaches that this occurs at a central (UNIQA) server, not at the client device. This is discussed next.

2) Combining Sharif and Bastian Would not Lead to the Subject Matter of the Claims

Even if the teachings of Sharif and Bastian were combined, one of ordinary skill in the art would still not arrive at the subject matter of claims 1, 8, and 15. This is because the claims specify classifying and routing of attachments at the vehicle (i.e., the client device). Sharif teaches processing attachments at a central (UNIQA) server and then sending only a single type of document (TV-HTML document) to the client device for presentation. Thus, there is no classification of attachments and routing of attachments based on classification that occurs at the client device. Bastian also teaches processing of attachments at a central server and then only uploading a summary and, if requested, individual attachments to the aircraft. Thus, even if Sharif's system was used in an aircraft application, it would still involve either Sharif's or Bastian's approach of processing attachments at a central server, not at the vehicle. Thus, even if combined, these two references do not teach the subject matter of Appellants' claims.

Claims 4, 11, and 18

Claims 4, 11, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharif in view of Bastian and further in view of Lazaridis et al. The Appellants respectfully traverse this rejection for at least the reason that Lazaridis does not make up for the above-noted deficiencies of Sharif and Bastian.

Claims 4, 11, and 18 each involves the determining the classification of the email attachment which includes determining whether the file is an audio-only file and routing the attachment to one of an audio unit or display screen based on the determination. The Examiner admits that Sharif and Bastian do not teach determining whether the file is an audio-only file and routing the attachment to one of an audio unit or display screen based on the determination. But the Examiner cites Lazaridis as teaching determining whether the file is an audio-only file and routing the attachment to one of an audio unit or display screen based on the determination. The Examiner argues that it would be obvious to modify Bastian using Lazaridis because doing so

would provide more effective and accurate delivery of data from a host system to a user's terminal.⁹

Lazaridis is directed to a system and method for pushing information from a host system to a mobile data communication device upon sensing a trigger event.¹⁰ In one embodiment, the host system is a desktop computer running a redirection program. The redirection program on the desktop receives messages from a server and determines whether the mobile device can receive the message based on message types pre-selected by the user or based on messages that the mobile device can process.¹¹ If the mobile device cannot accept the type of message, the redirection program redirects the message from the desktop computer to a fax or voice number where the user is located.¹² In another embodiment, the redirection program runs on a server.

First, as pointed out in Appellants' response filed April 18, 2007 and in the first Appeal Brief filed on March 3rd, 2008, Lazaridis does not teach determining a classification of an attachment at a vehicle or mobile device, nor does it suggest doing so since one of the objectives of Lazaridis is to avoid sending attachments to the mobile device that it cannot process and present to the user. Thus, even if combined, these three references do not teach or render obvious all of the subject matter of the independent claims. Further, the Examiner has not provided any proper basis for combining the references in any manner that renders the claims obvious. More specifically, the Examiner has not pointed to any teaching from any of the references whereby it would have been obvious to modify Sharif's system of accessing the World-wide Web using a television and remote control or Bastian's system to route different attachments to different devices on the plane. If anything, it would appear that modifying Bastian's system according to the teachings of Lazaridis would result in a system involving redirection of messages at Bastian's base station rather than at the mobile devices (i.e., rather than at the aircraft).

For at least these reasons and those articulated above in connection with the independent claims, Appellant respectfully traverse the rejection of claims 4, 11, and 18.

⁹ Final Office Action, page4, lines 19-21.

¹⁰ See abstract, Lazaridis et al., U.S. Patent No. 6,219,694.

¹¹ Lazaridis, col. 7, lines 57-60 and col. 7, line 66-col. 8, line 2.

¹² Lazaridis, col. 7, lines 60-65.

Claims 6, 7, 13, 14, 20, and 21

Claims 6, 7, 13, 14, 20, and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharif in view of Bastian and further in view of Ban. The rejection is respectfully traversed for at least the reason that Ban does not make up for the above-noted deficiencies of Sharif and Bastian.

Ban has been cited only for its disclosure of storing and deleting attachments from random access memory. However, the Examiner has not identified any teaching from Ban that would lead one of ordinary skill in the art to combine its teaching with Sharif and Bastian and abandon those references' teachings of the processing of attachments at a central server, rather than as recited in Appellants' claims. Thus, the Examiner not established a *prima facie* case of obviousness of these claims. Accordingly, the rejection of these claims should be overturned and the claims allowed.

Claims 5, 12, and 19

Claims 5, 12, and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharif in view of Bastian and Lazaridis and further in view of Official Notice taken by the Examiner. This rejection is respectfully traversed because, as discussed above, the three applied references do not render obvious the subject matter of the base independent claim, and because the additional fact asserted by the Examiner to be well known does not make up for the deficiencies of the three applied references.

The deficiencies of the combination of Sharif, Bastian, and Lazaridis are discussed above in connection with claims 4, 11, and 18. Apart from these references, the Examiner also takes Official Notice that it is well known to set a bit in a random access memory. Appellants respectfully submit that the Official Notice taken by the Examiner is not appropriate because, as stated by MPEP § 2144.03(A):

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under

final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

The Examiner's taking of Official Notice in the present circumstances violates the MPEP requirements laid out above. Moreover, in doing so the Examiner ignored the remaining limitation of these claims which indicates that the routing is dependent on the setting of the bit – a limitation that is itself not well known in the art.

Apart from the impropriety of the rejection based on Official Notice, Appellants again note that, even if used, the Official Notice taken by the Examiner does not make up for the above-noted deficiencies of the three applied references. Accordingly, the claims 5, 12, and 19 patentably define over the prior art and should be allowed.

Conclusion

In view of the foregoing, the Appellants request Board action to overturn the rejections of all claims. Each of the claims patentably defines over the prior art of record and should be allowed.

The Commissioner is authorized to charge any fees, or refund any overpayments, associated with this Appeal Brief to Deposit Account No. 07-0960.

Respectfully submitted,

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(viii) Claims Appendix

1. A method for accessing an email attachment from a mobile vehicle, the method comprising:
 - receiving an email attachment from a remote server at a vehicle telematics unit;
 - determining at the vehicle a classification of the email attachment; and
 - routing the email attachment within the vehicle based on the classification such that the email attachment is provided to a vehicle communication unit enabled to present the content of the email attachment.
2. The method of claim 1 further comprising receiving a notification signal at the telematics unit, and setting an internal software flag responsive to the notification signal.
3. The method of claim 2 wherein the internal software flag triggers receiving the email attachment at the mobile vehicle telematics unit.
4. The method of claim 1 wherein determining the classification of the email attachment comprises determining whether the file is an audio-only file and routing the attachment to one of a audio unit or display screen based on the determination.
5. The method of claim 4 further comprising setting a bit in a random access memory of the mobile vehicle telematics unit and thereby routing the email attachment to one of the audio unit or the display screen.
6. The method of claim 1 wherein the email attachment is temporarily stored in a random access memory within the telematics unit.
7. The method of claim 6 further comprising deleting the email attachment from the random access memory within the telematics unit after the email attachment has been routed to a vehicle communication unit.

8. A computer readable medium storing a computer program for a system to receive email attachments at a vehicle, comprising:

computer readable code for receiving an email attachment from a remote server at a vehicle telematics unit;

computer readable code for determining at the vehicle a classification of the email attachment;

computer readable code for routing the email attachment within the vehicle based on the classification such that the email attachment is provided to a vehicle communication unit enabled to present the content of the email attachment.

9. The computer readable medium of claim 8 further comprising computer readable code to receive a notification signal at the telematics unit, and set an internal software flag responsive to the notification signal.

10. The computer readable medium of claim 9 further comprising computer readable code for triggering receiving the email attachment at the vehicle telematics unit.

11. The computer readable medium of claim 8 further comprising computer readable code for determining whether the file is an audio-only file and routing the attachment to one of a audio unit or display screen based on the determination.

12. The computer readable medium of claim 11 further comprising computer readable code for setting a bit in the random access memory of the vehicle telematics unit and thereby routing the email attachment to one of the audio unit or the display screen.

13. The computer readable medium of claim 8 further comprising computer readable code for storing an email attachment temporarily in a random access memory within the vehicle telematics unit.

14. The computer readable medium of claim 13 further comprising computer readable code for deleting the email attachment from the random access memory within the telematics unit after the email attachment has been routed to a vehicle communication unit.

15. A system for accessing an email attachment from a vehicle, the system comprising:
means for receiving an email attachment from a remote server at a vehicle telematics unit;
means for determining at the vehicle a classification of the email attachment; and
means for routing the email attachment within the vehicle based on the classification such that the email attachment is provided to a vehicle communication unit enabled to present the content of the email attachment.

16. The system of claim 15 further comprising means for receiving a notification signal at the telematics unit, and setting an internal software flag responsive to the notification signal.

17. The system of claim 16 further comprising means for triggering receiving the email attachment at the vehicle telematics unit.

18. The system of claim 15 further comprising means for determining whether the email attachment file is an audio-only file and routing the attachment to one of a audio unit or display screen based on the determination.

19. The system of claim 18 further comprising means for setting a bit in the random access memory of the vehicle telematics unit and thereby routing the email attachment to one of the audio unit or the display screen.

20. The system of claim 15 further comprising means for temporarily storing the email attachment in a random access memory within the telematics unit.

21. The system of claim 20 further comprising means for deleting the email attachment from the random access memory within the telematics unit after the email attachment has been routed to a vehicle communication unit.

(ix) Evidence Appendix

None.

(x) Related Proceedings Appendix

None.